

### REMARKS

Claims 1-7, 9-13, and 15-19, as amended, and new claims 20-21 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, claims 1, 9, and 15 have been rewritten to further clarify the invention. In addition, several dependent claims have been rewritten or canceled to maintain consistency with the language now recited in the independent claims. Finally, claims 20-21 have been added to further define the object identified in the independent claims. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### THE DOUBLE PATENTING REJECTION

The Terminal Disclaimer filed August 2, 2007 was not accepted for non-payment of the requisite fee. As such, the Examiner maintained the previous provisional obviousness-type double patenting rejection based on claim 37 of co-pending U.S. Patent Application No. 10/861,441 ("the '441 application"). Office Action at Pages 2-3.

Based on the assumption that the Examiner plans to make a similar double patenting rejection in the '441 application once examined, Applicants respectfully submit that the Examiner should withdraw the rejection in the instant application and permit the instant application to issue as a patent. According to MPEP § 804(I)(b), if the "provisional" double patenting rejection is the only rejection remaining in the instant application, the Examiner should withdraw the rejection and permit the instant application to issue as a patent, thereby converting any future "provisional" double patenting rejections in the other application, i.e., the '441 application, into a double patenting rejection at the time the instant application issues as a patent.

In light of this discussion, Applicants respectfully withdraw the previously submitted Terminal Disclaimer and request reconsideration and withdrawal of the double patenting rejection.

A/72464002.1

**THE REJECTION UNDER 35 U.S.C. § 112**

Claims 2-3 and 9-14 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement for the reasons provided on page 5 of the Office Action.

The first paragraph of 35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112. Applicants respectfully submit that claims 2-3 and 9-14 are sufficiently enabled. In fact, the Written Description teaches that

[i]n order to extract useful information about the club and ball, such as that described above, the mathematical algorithm should be able to identify and match a pattern rapidly from a large list of stored patterns. It is desired that the time period for identification be about one second or less.

This time period preferably includes the total amount of time between receiving light reflected from the markers and the identification of the type of club or ball. This may include the time between detecting the placement of the markers, determining the mathematical relationship between the markers, and identifying the type of club or ball. However, steps may be included or excluded, depending on the type of mathematical algorithm that is used. Preferably, the present invention takes about six seconds or less to identify a pattern. More preferably, the present invention takes about one second or less to identify a pattern.

Page 8, lines 18-28. The Written Description then goes on to describe several algorithms including an Eigen value algorithm and a least square spatial error matching algorithm that may be used to accomplish this identification in the recited time periods. Page 8, line 29 to Page 9, line 8. As such, a skilled artisan would be able to practice the claimed invention without undue experimentation.

In sum, the disclosure "contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject

matter sought to be patented" and, thus, "must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein." MPEP § 2164.04. The Examiner has not indicated any such reason.

At a minimum, Applicants respectfully submit that the Examiner has not met his burden with respect to this rejection. In fact, the Examiner has not provided a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure in either office action. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993).

In an effort to hasten prosecution, however, Applicants have rewritten the rejected claims to remove the term "automatically" so as to more closely track the Written Description.

In light of this discussion, Applicants submit that there is no basis for the § 112 rejection. Reconsideration and withdrawal of the rejection is respectfully requested.

#### **THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103**

Claims 1-3, 7, 9, and 15-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2001/0029207 to Cameron *et al.* ("Cameron"). In addition, the Examiner rejected claims 4-6, 10-13, and 17-18 under § 103(a) as being obvious over Cameron in view of U.S. Patent No. 7,184,569 to Lawandy. Furthermore, claims 8 and 14 were rejected under § 103(a) as being obvious over Cameron in view of U.S. Patent No. 6,519,545 to Amano. Finally, the Examiner rejected claim 19 under § 103(a) as being obvious over Cameron. Applicants respectfully submit that none of the cited references disclose or suggest the present invention for at least the reasons that follow.

First, Cameron does not disclose each and every element of the invention. Based on his response to the previous arguments by Applicants, it appears that the Examiner bases his rejection on the broad assumption that, in order to "determine a 'suitable golf club configuration' for the golfer . . . a golf club's identity must be determine [sic] in order for the system to further analyze what is the 'suitable golf club configuration' for the golfer." Office Action at Page 2. Applicants respectfully submit that Cameron clearly teaches that, before reviewing and analyzing a golfer's swing, the golfer "must first be equipped with a putter of known dimensions (step 50)." Para. 0025 (emphasis added). Cameron further clarifies that the image acquisition occurs only after "golfer 10 has been fitted with a golf club of known dimensions." Para. 0027. As such, Cameron clearly

teaches that the golfer is provided with a specific putter with dimensions already known by system prior to any image acquisition. In other words, Cameron does not even suggest a system or method to identify a club or ball from an acquired image and further comparison of that image to a stored library of images, as presently recited.

In addition, the Examiner again takes a very broad reading of Cameron in an attempt to sustain his rejections in stating that Cameron teaches the concept of storing images and reference images. Office Action at Page 2. The sections cited by the Examiner ([0030-0031 and 0039]) refer to captured images of the golfer's swing [0033], which are then reviewed and analyzed by the user for various swing parameters including, for example, impact angle, which is obtained by the user manually drawing two lines over the image on the screen [0036]. There is no acquired image comparison to stored images in these sections.

And, despite the general suggestion by Cameron that the system can be programmed to recognize the shaft of the putter of known dimensions (para. 0040), there is nothing in this disclosure that explains or even suggests that such recognition of the actual putter via a stored library of image reference information, as presently recited. Rather, if read in context, this section pertains recognition of the location of the putter shaft at the time the putter impacts the ball. See Para. 0036 and 0040. Furthermore, Cameron is completely silent as to the use of Eigen values to perform this recognition step.

In sum, Cameron generally relates to launch performance monitors where the golfer's swing is analyzed and kinematic information is obtained. In contrast, while the present invention may be adapted to work with such performance monitors, the method and system presently recited is directed to identifying the type of club or ball being used. For at least these reasons, Applicants respectfully submits that Cameron does not disclose each and every feature presently recited. In addition, Cameron does not render obvious the present invention.

Moreover, neither of the secondary references cited by the Examiner cure the deficiencies of Cameron. For example, it appears that Lawandy was cited by the Examiner for its disclosure of types of markers that can be used on articles. Office Action at Pages 8-9. However, Lawandy is completely silent as to a method or system for identifying golf balls or golf clubs. Because Cameron lacks teaching of the salient features of the presently recited invention and Lawandy is similarly deficient, this combination of references would not render obvious the present invention to a skilled artisan.

Likewise, the combination of Cameron and Amano does not even suggest the presently recited invention. Amano is similar to Cameron in that it discusses a method of analyzing the trajectory of a golf club. As such, like Cameron, Amano is completely silent as to the identification of a plurality of golf clubs or golf balls based on stored reference information. Thus, even though Amano generally discloses the use of Eigen values (Col. 5, lines 48-51), at best, a skilled artisan might have been motivated to use Eigen values to analyze the trajectory of the golfer's swing in Cameron, not the actual equipment being used to swing the club at the ball.

In light of this discussion, Applicants respectfully submit that none of the cited references alone, or in any combination, anticipate or render obvious the presently recited invention. Reconsideration and withdrawal of the §§ 102 and 103 rejections is respectfully requested.

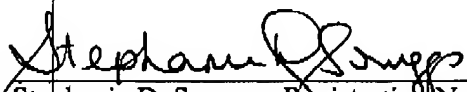
#### CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present remarks still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response two months to and including March 10, 2008. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 50-4047, Order No. 20002.0328.

Respectfully submitted,  
BINGHAM MCCUTCHEN LLP

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By:   
Stephanie D. Scruggs, Registration No. 54,432  
BINGHAM MCCUTCHEN LLP  
2020 K Street, NW  
Washington, D.C. 20006  
(202) 373-6755 Telephone  
(202) 373-6001 Facsimile